

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ROCKET TRADEMARKS PTY LTD,

Opposer,

v.

KOLTOV, INC.,

Applicant.



TTAB

Opposition No.

Our Account No. 14-1140

Our Order No. 181-264
C# M#

In Re Application No. 77/146,303
Filed: April 2, 2007
For the Mark ESSENTIAL ELEMENTS

Date: October 31, 2007

Box TTAB Fee

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Sir:

The document indicated below is attached for filing and is incorporated by reference. Fees are attached as calculated below:

- ☒ NOTICE OF OPPOSITION in 1 class(es) (\$ 300.00 per class) (6402) \$ 300.00
- ☐ PETITION FOR CANCELLATION in 0 class(es) (\$ 300.00 per class)(6401) \$ 0.00

TOTAL FEE TO BE CHARGED TO DEPOSIT ACCOUNT (identified below) \$ 300.00

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this form) to our **Account No. 14-1140**. A duplicate copy of this sheet is attached.

901 North Glebe Road, 11th Floor
Arlington, Virginia 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100
DMB:lfo

NIXON & VANDERHYE P.C.

By Atty: Duane M. Byers

Signature: _____

10-31-2007

**BOX TTAB
FEE**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

_____)	
Rocket Trademarks Pty Ltd)	
)	
Opposer)	
)	
v.)	Opposition No. _____
)	Application Serial No. 77146303
Koltov, Inc.)	
)	
Applicant)	
_____)	

NOTICE OF OPPOSITION

Opposer, Rocket Trademarks Pty Ltd, an Australian company with a business address of 1 Billabong Place, Burleigh Heads, Queensland, 4220, Australia, hereby opposes registration of the mark ESSENTIAL ELEMENTS that is the subject of application Serial No. 77146303, published in the Official Gazette of October 2, 2007, and requests that registration to Applicant be refused.

As grounds in support of its opposition, Opposer asserts as follows:

1. Opposer, for many years and since long prior to any date of first use upon which Applicant can rely, has adopted and continuously used the term ELEMENT as a trademark for a large variety of goods in, *inter alia*, International Classes 14, 18, 25 and 28, including bags, handbags, clothing and footwear.

11/02/2007 SWILSON1 00000013 141140 77146303

01 FC:6402 300.00 DA

2. Opposer is the owner of U.S. Trademark Registration Nos. 3303104, 3190386, 2610416, 2641494, 2647904, 2648000, 2667000 and 3055790 that include the trademark term ELEMENT as used in conjunction with, *inter alia*, bags and hand bags in Class 18, clothing and footwear in Class 25, and various goods in Class 28. Those registrations are valid, subsisting, unrevoked and uncanceled. Opposer also owns U.S. Trademark Application Serial No. 78629309 for the ELEMENT EDEN mark covering various goods in Class 14, 18 and 25, which application was filed in 2005 and stands allowed; and Opposer owns U.S. Trademark Application Serial No. 76641130 for the ELEMENT mark covering, *inter alia*, retailing services in Class 35, which application was filed in 2005 and stands published.

3. Applicant filed an "intent to use" application to register the mark ESSENTIAL ELEMENTS for:

Class 18: Handbags.

The application was filed on April 2, 2007, and was assigned Serial No. 77146303. No allegation of use has been filed.

4. Applicant's ESSENTIAL ELEMENTS trademark so resembles Opposer's previously used, registered and applied for ELEMENT trademarks as to be likely, when used in connection with the goods set forth in Applicant's application (including by way of verbal usage of the Applicant's mark that contains Opposer's ELEMENT trademark term), to cause confusion, mistake or deception within the meaning of Section 2(d) of the Trademark Act.

Indeed, Opposer has duly registered the ELEMENT trademark for, *inter alia*,

the identical goods (“hand bags”) in Class 18 – which date of registration dates back to 2001, and Opposer has an allowed application for the ELEMENT EDEN trademark for, *inter alia*, the identical goods (“hand bags”) in Class 18. Applicant has belatedly and improperly added a prefix word to a modified or pluralized version of Opposer's ELEMENT and ELEMENT EDEN marks and intends to use its ESSENTIAL ELEMENTS trademark on the “hand bag” goods in Class 18 – to the detriment of Opposer. Consumers and prospective consumers may believe that Applicant is associated with, affiliated with, sanctioned by, or licensed by Opposer, or that the ESSENTIAL ELEMENTS goods are Opposer’s goods and are a natural brand extension of Opposer’s broad spectrum of ELEMENT trademarked goods.

5. Opposer has successfully policed its ELEMENT trademarks against others, e.g., the ELEMENTS and Design trademark application that was the subject of Opposition No. 91157369, the FRESH ELEMENTS trademark application that was the subject of Opposition No. 91167930, the RAW ELEMENTZ trademark application that was the subject of Opposition No. 91161387, the ELEMENT 47 trademark that was the subject of Opposition No. 91167641, the DRY ELEMENTS trademark that was the subject of Application No. 78253324 (owned by Jantzen), the FRINGE ELEMENTS trademark that was the subject of Application No. 78350668, and others. The same success should follow with this opposition against the ESSENTIAL ELEMENTS trademark application.

6. Opposer's ELEMENT trademarks are famous and were famous before the first trademark use or application filing of the Applicant. Applicant's ESSENTIAL ELEMENTS mark is likely to dilute the fame and strength of Opposer's ELEMENTS marks. Thus, there is a likelihood of dilution, to the detriment of Opposer.

WHEREFORE, Opposer prays that the opposition be sustained and that registration to Applicant be refused.

Date: Oct. 31, 2007

Respectfully submitted,



Duane M. Byers
NIXON & VANDERHYE, P.C.
901 North Glebe Road, 11th Floor
Arlington, Virginia 22203-1808
703-816-4009 phone
703-816-4100 fax

Attorneys for Petitioner,
Rocket Trademarks Pty Ltd